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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,505	12/05/2003	Motoaki Nishikawa	Q78746	7848

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EXAMINER

DANIELS, MATTHEW J

ART UNIT	PAPER NUMBER
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1732

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/727,505	Applicant(s) NISHIKAWA ET AL.	
	Examiner Matthew J. Daniels	Art Unit 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, Claims 1-8 in the reply filed on 19 July 2006 is acknowledged.

Claim Objections

2. **Claims 1-8** are objected to because of the following informalities: Each method claim contains the limitation "a packaging case" or "and a packaging case" such that each claim appears to claim both the article and method of making in the same claim. See, for example, Claim 2, lines 1-2. However, the packaging case invention is withdrawn without traverse and the claims should reflect the statutory class of the elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by Goeb (USPN 5688573). **As to Claim 1**, Goeb teaches a method of forming a display which could be used as a display of a packaging case comprising the steps of:

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Irradiating a laser beam on a front face of an article which could be used as a packaging case produced by a paper sheet (50, Fig. 5) having a coloring agent (8:55-9:21) and a resin film (10, Figs. 1-6) protecting the front face and being on the front face (10, Figs. 1-6).

Evaporating the colored layer and the resin film with the laser beam (9:41-50), thereby forming the display (Figs. 1-6), which could inherently be used as a packaging case.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 5, 6, and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (USPN 6169266) in view of Ward (USPN 2192423). **As to Claim 1**, Hughes teaches a method of forming a display which could inherently be used as a display of a packaging case, the method comprising:

Irradiating a laser beam on a front face of a material that could be used as a packaging case having a colored layer and a resin film layer which protects the front face on the front face;

Evaporating the colored layer and the resin film layer by the laser beam, thereby forming the display on the article which could be used as a display on a packaging case.

Hughes is silent to the paper sheet. However, paper sheet labels are conventional and are disclosed, for example, by Ward. Ward teaches a package (page 1, right column, lines 30-35)

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having a paper substrate (page 2, right column, lines 35-50), and that it is obvious to ornament the surface (page 2, right column, lines 58-65).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Ward into that of Hughes because:

- a) Ward suggests ornamentation, which Hughes provides.
- b) Hughes suggests the method for any article where a design or indicia is required, which Ward provides.
- c) The paper substrate of Ward would provide a strong and durable support layer to the invention of Hughes.

As to Claims 5 and 6, Ward provides two paper layers (page 2, right column, lines 35-50). Any of the layers of Hughes is interpreted as the claimed colored layer or the protecting film. In the combination of Ward and Hughes where Ward provides two paper layers or sheets and Hughes provides multiple layers of coating, each of which performs the function of protecting or coloring, the claim limitations are met. As to Claim 8, the packaging case of Ward could be used for any of the recited articles (Figures), and in the alternative, it would have been prima facie obvious to adjust the size to store the claimed articles.

5. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (USPN 6169266) in view of Ward (USPN 2192423), and further in view of Robertson (USPN 6007929). As to Claim 2, Hughes is silent to a carbon dioxide laser. However, carbon dioxide lasers are conventional for laser engraving and marking. For example, Robertson teaches a multilayer coating, one layer evaporated or ablated (Fig. 4), and that a carbon dioxide laser is preferred for

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its long operating life (4:39-50). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Robertson into that of Hughes because Hughes suggests a laser marking method and the carbon dioxide laser of Robertson would provide a long operating life.

6. **Claims 3 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (USPN 6169266) in view of Ward (USPN 2192423), and further in view of Sonobe (USPN 6244176). Hughes and Ward teach the subject matter of Claim 1 above under 35 USC 103(a).

As to Claims 3 and 7, any of the layers of Hughes is interpreted as the claimed colored layer or the protecting film. In the combination of Ward and Hughes where Ward provides two paper layers or sheets and Hughes provides multiple layers of coating, each of which performs the function of protecting or coloring, the claim limitations drawn to the configuration of layers are met.

Hughes is silent to the UV coating material. However, Sonobe teaches UV coating material (ultraviolet curing ink, 5:16-17). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Sonobe into that of Hughes because Hughes suggests wear resistant (2:32) inks (2:47) and the thermosetting inks of Sonobe would provide favorable wear resistance. Additionally, Hughes suggests a particular order or layering of inks (black, cyan, magenta, yellow, white), which Sonobe provides.

7. **Claim 4** rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (USPN 6169266) in view of Ward (USPN 2192423), Robertson (USPN 6007929), and further in view of

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Sonobe (USPN 6244176). Hughes, Ward, and Robertson teach the subject matter of Claim 2 above under 35 USC 103(a). **As to Claim 4**, Hughes is silent to the UV coating material. However, Sonobe teaches UV coating material (ultraviolet curing ink, 5:16-17). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Sonobe into that of Hughes because Hughes suggests wear resistant (2:32) inks (2:47) and the thermosetting inks of Sonobe would provide favorable wear resistance. Additionally, Hughes suggests a particular order or layering of inks (black, cyan, magenta, yellow, white), which Sonobe provides.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJD 4/10/07

MJD

CJ
CHRISTINA JOHNSON
SUPERVISORY PATENT EXAMINER
4/14/07